

REMARKS

Claims 10-28 are pending. Claims 15-28 are cancelled with out prejudice, and claims 29-38 have been added. Claims 10-14 and 29-38 will therefore be pending upon entry of the proposed amendments.

The Examiner has indicated that claim 28, which depends from base claim 10, would be allowable if rewritten in independent form. According to the Examiner (Office Action, page 6):

The prior art of record does not fairly suggest, teach or disclose using an effective dosage of 500 mg pantothenic acid. (This dosage is orders of magnitude higher than the amounts used by Hyodo et al.).

With regard to the above-quoted passage from the present Office Action, Applicants do not necessarily agree that there are no other reasons for the allowability of claim 28.

Applicants have amended claim 10 to include the limitations of claim 28. More specifically, Applicants have replaced the phrase "an effective amount" with the phrase "about 500 mg."

Applicants have amended the phrase "disorder from" to read "disorder selected from the group consisting of."

New claim 29 differs from claim 10 as currently amended with respect to the clause defining the injectable composition. Specifically, claim 29 recites "an injectable composition comprising about 500 mg of pantothenic acid ..." (emphasis added) instead of "an injectable composition consisting essentially of about 500 mg of pantothenic acid ..." Support for new claim 29 can be found throughout the Specification, e.g., at page 1, line 26 through page 2, line 11. New claims 30-33, which depend from claim 29, include the subject matter of pending claims 11-14.

New claim 34 is directed to: "[a] method of alleviating inflammation and pain in an inflamed and painful joint of a mammal, the method consisting of administration of an injectable composition consisting of an effective pain relief amount of pantothenic acid or a derivative thereof and a solvent therefor ..." (emphases added). Support for new claim 34 can be

found throughout the Specification, e.g., at page 1, lines 17-19 and 26-28. New claims 35-38, which depend from claim 34, include the subject matter of pending claims 11-14.

Applicants have amended the Specification to include priority data as required by the Examiner.

No new matter is introduced by these amendments.

Claim Objections

The Examiner has objected to the following pairs of claims as being “substantial duplicates” of one another: claims 15 and 20; 17 and 22; 18 and 23; 19 and 24; and 25 and 26. This objection is moot in view of the cancellation of the aforementioned claims.

Rejection under 35 U.S.C. § 112, second paragraph

Claim 11 is rejected because “it recites an improper Markush group” (Office Action, page 3). This rejection is moot in view of the amendment to claim 11.

Rejection under 35 U.S.C. § 102(b)

Claims 10-15 and 20 remain rejected as being anticipated by Hyodo et al., U.S. Patent 5,260,289 (Hyodo).

The rejection of claims 15 and 20 are moot in view of their cancellation.

Applicants respectfully disagree with the grounds for the rejection. However, to expedite prosecution, Applicants have amended to claim 10 to require that the amount of pantothenic acid (or a derivative thereof) administered is “about 500 mg.” Hyodo does not teach or suggest the administration of about 500 mg of pantothenic acid (alone or in combination with another ingredient). Therefore, Hyodo does not anticipate claim 10 because this reference does not teach every limitation of claim 10. Since claims 11-14 depend from claim 10, then dependent claims 11-14 are also not anticipated by Hyodo. Applicants respectfully request that the rejection be withdrawn and not be applied to new claims 29-38.

Rejections under 35 U.S.C. § 103(a)

Claims 16, 21, and 27 are rejected as being unpatentable over Hyodo in view of Speck, U.S. Patent 4,870,061. This rejection is moot in view of the cancellation of claims 16, 21, and 27.

Claims 17-19 and 22-26 are rejected as being unpatentable over Hyodo in view of Hills, U.S. Patent 6,133,249. This rejection is moot in view of the cancellation of claims 17-19 and 22-26.

Claims 15 and 20 are rejected as being unpatentable over Hyodo. This rejection is moot in view of the cancellation of claims 15 and 20.

CONCLUSION

Applicants submit that all claims are in condition for allowance.

Enclosed is a \$225 check for the Two Month Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050, referencing Attorney Docket No.: 13596-003US1.

Respectfully submitted,

Date: June 27, 2005

John T. Kendall
John T. Kendall, Ph.D.
Reg. No. 50,680

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906